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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,461

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Fraser Jon Edmund Johnson

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10/14/2008

Saul Ewing LLP (Philadelphia)

Attn: Patent Docket Clerk

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Harrisburg, PA 17101

EXAMINER

NGUYEN, HOANG M

ART UNIT

PAPER NUMBER

3748

MAIL DATE

DELIVERY MODE

10/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/598,461	<b>Applicant(s)</b> JOHNSON, FRASER JON EDMUND	
	<b>Examiner</b> Hoang M. Nguyen	<b>Art Unit</b> 3748	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Applicant's amendment dated September 15, 2008, has been fully considered but not found persuasive.

Applicant repeated his argument from the previous amendment that his invention is heave-resistance and further explained that his cables are under tension, and the cables in the Youlton are not. The Examiner strongly disagrees because all cables are under tension if there are forces act on the cable. In the wave power plant, all cables are under tension if the waves act on the cables. Moreover, the Examiner would like to repeat his opinions in the previous Office Action, please note "heave-resistance" does not mean "non-heave". On page 2, lines 17-23, Applicant clearly discloses that "heave-resistant" can be achieved by tethering the system to the sea bed and the system may be rise and fall with tidal activity. Accordingly, because Applicant admits that his system does rise and fall with tidal activity, the cables in his invention are not different from the prior art.

Applicant added a new limitation "the lower end of each chamber being open to water above the wave base". This is clearly new matter because nowhere in the specification does Applicant disclose that limitation. All figures in this application clearly show the bottoms 26 are way under the water level 16, 32. Applicant points out in the specification, page 7, line 19, that "as the wave crest approaches the device 10, the water level 32 within chamber 26 rises...." and explained this only happens if the bottom of the chamber is above the water base. The Examiner disagrees. Figure 4 clearly

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shows the bottom 26 is under the water level 32, and the water may rise because the system heaves. Again, the Examiner must emphasize that the system of this invention is only heave-resistance, but does heave when the waves pass by (note page 6, lines 23-24).

Applicant argued the cables 15 of Hagen are connected to the monobuoy 14 only. The Examiner disagrees. Please note column 2, lines 64-65, "cables 15 extending to an array of bottom anchors 16", and figure 2 shows the anchors 16 at the sea bed.

Applicant argued the Examiner did not address his argument about the different draughts of the cells in Hagen. The Examiner disagrees because as noted in the previous Office Action, the cells in Hagen have different sizes and lengths and therefore must have different draughts.

For the reasons set forth above, this Office Action has been rejected as follows.

Claims 16-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant added a new limitation "the lower end of each chamber being open to water above the wave base". This is clearly new matter because nowhere in the specification does Applicant disclose that limitation. All figures in this application clearly show the bottoms 26 are way under the water level 16, 32.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-21, 23-24, 26-29, are rejected under 35 U.S.C. 102(b) as being anticipated by US 5770893 (Youlton).

Youlton discloses a wave energy converter comprising vessel 17, a plurality of chambers 14 having different lengths and draughts to optimize the performance of the wave energy device for different wave periodicity.

Claims 16-21, 23-24, 26-29, are rejected under 35 U.S.C. 102(b) as being anticipated by US 4123185 (Hagen et al).

Hagen et al discloses a wave energy converter comprising vessel 47, a plurality of chambers 20 having different lengths and draughts to optimize the performance of the wave energy device for different wave periodicity. Also, please note the flexible lines 15 and the anchors 16.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22, 25, 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 5770893 (Youlton). Youlton discloses all the claimed subject matter as set forth above in the rejection of claim 16, but does not disclose different types of flow paths, tubes or energy extractor means. However, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to select different types of flow paths, tubes and energy extractors In Youlton for the purpose of achieving appropriate power outputs.

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Nguyen whose telephone number is (571) 272-4861. The examiner can normally be reached on Tuesday--Friday from 12:30 AM to 10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hoang M Nguyen/  
Primary Examiner, Art Unit 3748

HOANG NGUYEN  
PRIMARY EXAMINER  
ART UNIT 3748

Hoang Minh Nguyen  
10/15/2008